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| 10/509,838 | 09/30/2004 | Shigetaka Kudou | 6640/69077 | 2252 |

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| EXAMINER |
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DINH, TAN X

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| ART UNIT | PAPER NUMBER |
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2627

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04/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/509,838 | Applicant(s) KUDOU, SHIGETAKA | |
| | Examiner TAN X. DINH | Art Unit 2627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1) This application is a **371** of **PCT/JP03/04707**, filed on **4/14/2003**.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d) or (f). The certified copy of the priority documents have been received in this **National Stage Application** from the International Bureau (PCT Rule 17.2(a)).

The foreign document identifies as:

JAPAN **2002-112367**, filed on **4/15/2002**.

2) The amendment/preliminary amendment filed **9/30/2004** is acknowledged.

3) The **I.D.S** filed **3/06/2007** has been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form **PTO-1449** or **PTO/SB/08** is(are) attached herein.

4) The drawings are objected to because figures **38 and 39** should be designated by a legend such as --**PRIOR ART**-- since only that which is old is illustrated. See MPEP § 608.02(g).

Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

The replacement sheet(s) should be labeled "REPLACEMENT SHEET" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures.

If the changes are not accepted by the Examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5) Claims *6,7,14 and 15* are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase " when it is estimated based on said second management data that the main data is being reproduced from said first recording medium, recording of said main data being reproduced into said second recording medium is restricted " (claims 6 and 14) is unclear and cannot be understood. Where is the teaching of this feature ?.

The phrase " to renew said second management data based on

management data concerning the main data to be recorded in the second recording medium that is reproduced from said first recording medium ” (claims 7 and 15) is also unclear and cannot be understood. What is the meaning of this phrase ?.

6) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

7) (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8) Claims *1,2,7,8,9,10,15 and 16*, as understood by the meaning of 112, 2nd above, are rejected under 35 U.S.C. 102(b) as being anticipated by **BERHAN (6,487,145)**.

BERHAN discloses a recording and reproducing apparatus as claimed in claim 1, comprising:

reproducing means for reproducing main data and first management data for managing main data that are recorded in a first recording medium (Fig.2A, CD changer 142, Fig.2B, CD reader 106);

recording and reproducing means for recording in and

reproducing from a second recording medium the main data reproduced from first recording medium and second management data for managing main data to be recorded in second record medium (Fig.2A, hard-disk 118, Fig.2B, storage media 108);

end detection means for detecting an end of each track of the main data reproduced by said reproducing means and complete reproducing detection means for detecting that each track has been reproduced completely (Figs.11-12B, each track has been detected the ending and completing of reproducing before records separately on data base. See data structure for each track and file system for each track);

management data renewal means for renewing the second management data to be recorded in second recording medium based on detection results from end detection means and complete reproducing detection means (Figs.11-12B, the management information (track identification, a track length and sector addresses. The track identification is preferably the name of the track. Alternatively, if the music data has CD text, the track may be identified by the track name, the artist's name, and genre (e.g., rock, jazz, etc.)) of each track in CD-1 to CD-N are changed from CD to database (hard-disk));

control means for controlling recording of the main data reproduced from first recording medium into second recording medium based on second management data and for controlling management data

renewal means so as to renew second management data when main data is recorded in second recording medium (Fig.3, control 110).

As to claim 2, BERHAN shows the second management is renew based reproduction order of track contained in first management data (Fig.4, CD-1 to CD-N are recorded on hard disk 120 as same order CD-1 to CD-N. See also figures 11-12B, the management information of each track on CD are recorded on database 702 with same data structure).

As to claims 7 and 15, BERHAN shows the feature of recording second management data into second recording medium when the main data to be recorded on second recording medium (Figures 11-12B, the management data of audio tracks on CD are recorded together with audio track to database 702).

As to claim 8, the divider means is inherent in BERHAN's audio recording device since the track on CD are divided and recorded separately on hard-disk).

Method claim(s) 9 is drawn to the method of using the corresponding apparatus claimed in claim 1. Therefore, method claim 9 is rejected for the same reasons of anticipation (obviousness) as used above.

Claim 10 is rejected with the same reasons set forth in claim 2 above.

Claim 16 is recorded with the same reasons set forth in claim 8 above.

9) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10) Claims *6 and 14*, as understood by the meaning of 112, 2nd above, are rejected under 35 U.S.C. 103(a) as being unpatentable over **BERHAN (6,487,145)**.

BERHAN discloses all the subject matter as claimed in claims 6 and 14, *except to specifically shows that* when the main data is being reproduced from first recording medium which restricts to record main data into second recording medium. It would have been obvious matter of design choice to modify the BERHAN's audio recording by restricting the recording audio data into second medium during reading out from the first medium as claimed since audio track, during recording or editing processes, can be selectively performed any desirable operations, such as, stopping

the recording of any audio track to second medium, pausing, adding, deleting, etc.,.

11) Claims 3-5 *and* 11-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form **PTO-892** is attached herein.

13) Any inquiry concerning this communication or earlier communications from the examiner should be directed to **TAN Xuan DINH** whose telephone number is **571-272-7586**. The examiner can normally be reached on **MONDAY-FRIDAY** from **8:30AM** to **5:30PM**.

The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the **Patent Application Information Retrieval (PAIR)** system. Status information for published applications may be obtained from either **Private PAIR** or **Public PAIR**. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197** (toll-free).

/TAN Xuan DINH/
Primary Examiner, Art Unit 2627
April 10, 2008